

**REMARKS**

At the outset, the Examiner is thanked for the thorough review and consideration of the subject application. The Non-Final Office Action of April 18, 2003 has been received and contents carefully reviewed.

Claims 1-10, 12-18, and 20-22 are currently pending.

In the Office Action, the Examiner rejected claims 1-10, 12-18, and 20-22 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The rejection of these claims is traversed and reconsideration of the claims is respectfully requested in view of the following remarks.

In rejecting the claims under 35 U.S.C. §112, first paragraph, the Examiner stated “[t]he specification does not disclose the composition of the... [FLC]... material which still maintains the smectic phase when the liquid crystal panel is cooled to -20 degrees so as to produce monostable alignment of [FLC]...” The Examiner then stated that the “composition of the FLC material is essential to support the claimed invention” and cited to Applicant’s cited Asao et al., allegedly teaching “FLC-A became crystallized at -7.2 degrees C.”

In order to make a rejection under 35 U.S.C. §112, first paragraph, the Examiner has the burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP § 2164.04. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. See MPEP § 2164.01.

The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a

conclusion reached be weighing factual considerations including, for example, the nature of the invention, the state of the prior art, the level of one of ordinary skill in the art, the level of predictability, etc.

While references can be supplied to support a *prima facie* case of lack of enablement, specific technical reasons are always required. Moreover, Applicants respectfully submit it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factual considerations while ignoring one or more of the others. The Examiner's analysis must consider all the evidence related to each of the above factual considerations, and any conclusion of nonenablement must be based on the evidence as a whole. See MPEP § 2164.04.

Applicant respectfully submits that it cannot be reasonably presumed that all FLC material has a crystallization temperature of  $-7.2^{\circ}\text{C}$  simply because Asao et al. teaches a crystallization temperature of a particular type of FLC material to be  $-7.2^{\circ}\text{C}$ . Applicant respectfully submits one reasonably skilled in the art of fabricating FLC devices would readily appreciate that crystalline phase transitions of various types of FLC occurs over a range of well documented temperatures. Moreover, Applicant respectfully submits one of ordinary skill in the art would readily recognize types of FLC material that exhibit the phase transition characteristics described by the specification of the instant application. Accordingly, Applicant respectfully submits the present application is in full compliance with 35 U.S.C. § 112, first paragraph.

Further, Applicant respectfully submits it is improper for the Examiner to conclude that the disclosure of the present invention is not enabling based on an analysis of only one reference while ignoring the actual state of the art, the level of those reasonably skilled in the

Application No.: 09/749,440  
Group Art Unit: 2871

Docket No.: 8733.373.00  
Page 4

art, the level of predictability in the art, etc. Accordingly, Applicant respectfully submits the Examiner has not established a *prima facie* case of nonenablement under 35 U.S.C. § 112, first paragraph.

Applicants believe the application in condition for allowance and early, favorable action is respectfully solicited. Should the Examiner deem that a telephone conference would further the prosecution of this application, the Examiner is invited to call the undersigned attorney at (202) 496-7500.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136. Please credit any overpayment to deposit Account No. 50-0911.

Respectfully submitted,

MCKENNA LONG & ALDRIDGE, LLP

Date: July 9, 2003

By



Rebecca Goldman Rudich  
Registration No.: 41,786

Kurt M. Eaton  
Registration No.: 51,640

1900 K Street, N.W.  
Washington, D.C. 20006  
Telephone No.: (202) 496-7500  
Facsimile No.: (202) 496-7756